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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,373	05/25/2001	Richard L. Schwartz	SMIO.0100006	4418

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EXAMINER

PHILLIPS, HASSAN A

ART UNIT	PAPER NUMBER
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2151

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/866,373

Applicant(s)

SCHWARTZ ET AL.

Examiner

Hassan Phillips

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-101 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-101 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/19/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The Information Disclosure Statements (IDS) filed May 24, 2004, February 4, 2004, August 8, 2003, June 11, 2003, and October 22, 2002, have been received and considered by the examiner.

Specification

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

1. Claim 89, is objected to because of the following informalities: The Examiner feels the Applicant intended for claim 89 to be dependent on claim 87, and not claim 97. In order for the Examiner to advance prosecution of the application for patent, the Examiner has interpreted claim 89 as being dependent upon claim 87. Appropriate correction is required.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 9-21, 47-49, 55-67, 93-100, are rejected under 35 U.S.C. 102(e) as being anticipated by Kay et al. (hereinafter Kay), U.S. Patent 6,430,602.

3. In considering claims 1, 47, and 93, Kay teaches a method, program product, and apparatus capable of:

Facilitating a mediated communication session between a first communication device and a second communication device, wherein facilitating the mediated communication session includes receiving a request for implementing an interactive communication session; receiving a reply for accepting the request; and implementing the interactive communication session between the first communication device and a third communication device in response to receiving the reply for accepting the request, (col. 4, line 58 through col. 6, line 42).

4. In considering claims 2, 48, and 99, Kay teaches receiving the request for implementing including receiving the request for implementing from the first communication device; and receiving the reply for accepting the request including receiving the reply for accepting the request from the second communication device. See col. 4, lines 58-67, col. 5, lines 1-7.

5. In considering claims 3, 49, and 100, Kay provides a means for receiving the request for implementing from the first communication device including receiving the request for implementing from a wireless communication device capable of transmitting and receiving data packets. See col. 4, lines 58-67, col. 5, lines 1-7.

6. In considering claims 9, and 55, Kay teaches preparing log-in information for the interactive communication session; transmitting the log-in information to the second communication device; receiving the log-in information from the third communication device, and authenticating the log-in information. See col.10, lines 8-57.

7. In considering claims 10, and 56, Kay teaches generating a passcode. See col.10, lines 8-57.

8. In considering claims 11, and 57, Kay teaches generating a chronologically referenced passcode; and authenticating the log-in information including determining an elapsed period of time from when the chronologically referenced passcode was

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generated and verifying that the elapsed period of time is less than a prescribed validation period for which the passcode is valid. See col.10, lines 8-57.

9. In considering claims 12, and 58, it is inherent in the teachings of Kay that a time-stamped passcode is generated. See col.10, lines 8-57.

10. In considering claims 13, and 59, Kay teaches receiving the request for implementing including receiving the request for implementing from the first communication device wherein the first communication device is a mediated party communication device; and preparing the log-in information including receiving a mediated party-specified passcode from the first communication device. See col.10, lines 8-57.

11. In considering claims 14, and 60, Kay teaches receiving the request for implementing including receiving the request for implementing from the first communication device wherein the first communication device is a mediated subscriber communication device; and preparing the log-in information including receiving a mediated subscriber-specified passcode from the first communication device. See col.10, lines 8-57.

12. In considering claims 15, and 61, Kay teaches generating an interactive communication session log-in address. See col.10, lines 8-57.

13. In considering claims 16, and 62, Kay teaches generating a unique communication network log-in address. See col.10, lines 8-57.

14. In considering claims 17, and 63, Kay teaches generating a mediation subscriber specific Internet website address. See col.10, lines 8-57.

15. In considering claims 18, and 64, Kay teaches transmitting a text session authorization notification to an interactive communication session system after authenticating the log-in information. See col.10, lines 8-57.

16. In considering claims 19, and 65, Kay teaches invalidating the passcode after a prescribed validation period elapses. See col.10, lines 8-57.

17. In considering claims 20, and 66, Kay teaches invalidating the passcode after implementing the interactive communication session. See col.10, lines 8-57.

18. In considering claims 21, and 67, Kay teaches managing the interactive communication session between the first communication device and the third communication device after performing an operation for implementing the interactive communication session. See col.6, line 43, through col. 8, line 18.

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19. In considering claims 94-97, Kay teaches facilitating the mediated communication session; receiving the reply for accepting the request; and implementing the interactive communication session. See col. 4, lines 58-67, col. 5, lines 1-7.

20. In considering claim 98, Kay teaches managing the interactive communication session. See col. 6, line 43, through col. 8, line 18.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 4, 50, 101, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kay in view of Kimura, U.S. Patent 5,758,280 (supplied by applicant).

3. In considering claims 4, 50, and 101, although Kay shows substantial features of the claimed invention, Kay fails to expressly disclose:

a) The second communication device being a wireless communication device.

Nevertheless, in a similar field of endeavor, Kimura teaches:

- a) Receiving replies for accepting requests from wireless communication devices, col. 1, lines 51-67.

Furthermore, communicating between wireless communication devices was well known in the art at the time of the present invention. Thus, given the teachings of Kimura, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Kay to show the second communication device being a wireless communication device. This would have enhanced the teachings of Kay by allowing users to interact with other wireless devices, as well as remotely located servers, Kay col. 2, lines 31-56.

4. Claims 5-8, 33-46, 51-54, 79-92, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kay in view of Ouzounidis et al. (hereinafter Ouzounidis), U.S. Patent Pub. 2002/0007397.

5. In considering claims 5, and 51, although Kay shows substantial features of the claimed invention, Kay fails to expressly disclose:

- a) Facilitating a voice based communication session.

Nevertheless, in a similar field of endeavor, Ouzounidis teaches:

- a) A mediated communication session including facilitating a voice-based mediated communication session, (page 2, paragraph 25, through page 3, paragraph 35).

Thus, given the teachings of Ouzounidis, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Kay to show the facilitated communication session including facilitating a voice-based mediated communication session. This would have enhanced the teachings of Kay, and made the method, program product, and apparatus taught by Kay more versatile by allowing a communication session to be either text or voice, Ouzounidis, page 1, paragraph 13.

6. In considering claims 6, 36, 52, and 82, Ouzounidis teaches facilitating voice-based communication between a mediation system and a second communication device. See page 3, paragraph 35. One of ordinary skill in the art would combine the teachings of Kay with Ouzounidis for the reasons indicated in consideration of claims 5, 33, 51, and 79.

7. In considering claims 7, and 53, Kay teaches receiving the request for implementing including receiving the request for implementing from the first communication device; and receiving the reply for accepting the request including receiving the reply for accepting the request from the second communication device. See col. 4, lines 58-67, col. 5, lines 1-7.

8. In considering claims 8, and 54, although Kay shows substantial features of the claimed invention, Kay fails to expressly disclose:

- a) Receiving the request from the second device, and replying from the first device.

Nevertheless Ouzounidis teaches:

- a) Sending and receiving messages by mobile devices over mobile networks, page 2, paragraph 25.

Thus, given the teachings of Ouzounidis, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Kay to show the second communication device requesting implementing, and receiving the reply for accepting the request including receiving the reply for accepting the request from the first communications device. This would have enhanced the teachings of Kay by allowing users to interact with other wireless devices, as well as remotely located servers, Kay col. 2, lines 31-56.

9. In considering claims 33, and 79, Kay teaches a method, and data processor program product, comprising:

Facilitating a mediated communication session between a first communication device and a second communication device, wherein facilitating the mediated communication session includes receiving a request for implementing a text-based interactive communication session; receiving a reply for accepting the request; and implementing the text-based interactive communication session between the first communication device and a third communication device in response to receiving the reply for accepting the request; and managing the interactive communication session

between the first communication device and the third communication device after performing an operation for implementing the interactive communication session, (col. 4, line 58 through col. 8, line 18).

Although Kay shows substantial features of the claimed invention, Kay fails to expressly disclose:

- a) Facilitating a voice based communication session.

Nevertheless, in a similar field of endeavor, Ouzounidis teaches:

- a) A mediated communication session including facilitating a voice-based mediated communication session, (page 2, paragraph 25, through page 3, paragraph 35).

Thus, given the teachings of Ouzounidis, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Kay to show the facilitating a voice-based mediated communication session between the first communication device and second communication device. This would have enhanced the teachings of Kay, and made the method, and data processor program product taught by Kay more versatile by allowing a communication session to be either text or voice, Ouzounidis, page 1, paragraph 13.

10. In considering claims 34, and 80, Kay provides a means for receiving the request for implementing from the first communication device including receiving the request for implementing from a wireless communication device capable of transmitting and receiving data packets. See col. 4, lines 58-67, col. 5, lines 1-7.

11. In considering claims 35, and 81, although Kay shows substantial features of the claimed invention, Kay fails to expressly disclose:

- a) The second communication device being a wireless communication device.

Nevertheless, Ouzounidis teaches:

- a) Wireless devices capable of transmitting and receiving data packets, (page 2, paragraph 25).

Furthermore, communicating between wireless communication devices was well known in the art at the time of the present invention. Thus, given the teachings of Ouzounidis, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Kay to show the second communication device being a wireless communication device. This would have enhanced the teachings of Kay by allowing users to interact with other wireless devices, as well as remotely located servers, Kay col. 2, lines 31-56.

12. In considering claims 37, and 83, Kay teaches generating a passcode and an interactive communication session log-in address for the interactive communication session; transmitting the passcode and the interactive communication session log-in address to the second communication device; receiving the passcode from the third communication device; and authenticating the passcode. See col.10, lines 8-57.

13. In considering claims 38, and 84, Kay teaches preparing generating the passcode including generating a time-stamped passcode; and authenticating the passcode including determining an elapsed period of time from when the time-stamped passcode was generated and verifying that the elapsed period of time is less than a prescribed validation period for which the time-stamped passcode is valid. See col.10, lines 8-57.

14. In considering claims 39, and 85, Kay teaches generating a unique communication network log-in address. See col.10, lines 8-57.

15. In considering claims 40, and 86, Kay teaches generating a mediation subscriber specific Internet website address. See col.10, lines 8-57.

16. In considering claims 41, and 87, although Kay shows substantial features of the claimed invention, Kay fails to expressly disclose:

- a) Displaying textual dialog on the third communication device.

Nevertheless, Kay does teach:

- a) Displaying textual dialog on devices in order to "chat" with one or more other users, col. 1, lines 43-48.

Thus, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Kay to displaying textual a textual dialog interface on a visual display of the third communication device. This would have enhanced the teachings of Kay by

allowing users to interact with other wireless devices, as well as remotely located servers, Kay col. 2, lines 31-56.

17. In considering claims 42, and 88, Kay teaches displaying a text entry field for enabling a text message to be composed and a dialog thread field for displaying textual dialog between the first and third communication devices. See col. 5, line 8, through col. 7, line 35.

18. In considering claims 43, and 89, Kay teaches the dialog response including displaying a predefined dialog response. See col. 7, lines 36-59.

19. In considering claims 44, and 90, the teachings of Kay provide a means for displaying the predefined dialog response including selecting the predefined dialog response from a group of predefined dialog responses including a dialog response for responding in the affirmative manner to a textual message, a dialog response for responding in a negative manner to a textual message, and a dialog response for responding that a response to the textual message will be momentarily delayed. See col. 7, lines 36-59.

20. In considering claims 45, and 91, Kay teaches displaying the dialog response message including analyzing at least a portion of the textual message. See col. 7, lines 36-59.

21. In considering claims 46, and 92, the teachings of Kay provide a means for displaying a response for initiating a transfer from the interactive communication session to a telephonic communication session\.. See col. 7, lines 36-59.

22. Claims 22-32, 68-78, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kay.

23. In considering claims 22, and 68, although Kay shows substantial features of the claimed invention, Kay fails to expressly disclose:

- a) Receiving a communication session authorization notification.

Nevertheless, Kay does teach:

- a) Authorized users receiving a notification in response to another authorized user logging into a network for the purpose of implementing an interactive communication session, col. 1, lines 43-58.

Furthermore, as indicated by Kay, receiving notifications for the purpose of implementing an interactive communication session was well known in the art at the time of the present invention. Thus, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Kay to show receiving an interactive communication session authorization notification in response to implementing the interactive communication session. This would have provided a secure means for implementing an interactive communication session by letting the user know that the

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user is authorized and ready to begin a communication session. This also would have assured the user that the communication session was safe from access by unauthorized users, Kay, col.10, lines 8-57.

24. In considering claims 23, and 69, although Kay shows substantial features of the claimed invention, Kay fails to expressly disclose:

- a) Displaying textual dialog on the third communication device.

Nevertheless, Kay does teach:

- a) Displaying textual dialog on devices in order to "chat" with one or more other users, col. 1, lines 43-48.

Thus, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Kay to displaying textual a textual dialog interface on a visual display of the third communication device. This would have enhanced the teachings of Kay by allowing users to interact with other wireless devices, as well as remotely located servers, Kay col. 2, lines 31-56.

25. In considering claims 24, and 70, Kay teaches displaying a text entry field for enabling a text message to be composed and a dialog thread field for displaying textual dialog between the first and third communication devices. See col. 5, line 8, through col. 7, line 35.

26. In considering claims 25, and 71, Kay teaches the dialog response including displaying a predefined dialog response. See col. 7, lines 36-59.

27. In considering claims 26, and 72, the teachings of Kay provide a means for displaying a dialog response for responding in the affirmative manner to a textual message. See col. 7, lines 36-59.

28. In considering claims 27, and 73, the teachings of Kay provide a means for displaying a dialog response for responding in a negative manner to a textual message. See col. 7, lines 36-59.

29. In considering claims 28, and 74, the teachings of Kay provide a means for displaying a dialog response for responding that a response to the textual message will be momentarily delayed. See col. 7, lines 36-59.

30. In considering claims 29, and 75, Kay teaches displaying a contextual response message associated with a context of a textual message. See col. 7, lines 36-59.

31. In considering claims 30, and 76, Kay teaches displaying the contextual response message including analyzing at least a portion of the textual message. See col. 7, lines 36-59.

32. In considering claims 31, and 77, the teachings of Kay provide a means for displaying an action-based response for initiating a system-implemented action. See col. 7, lines 36-59.

33. In considering claims 32, and 78, the teachings of Kay provide a means for displaying a response for initiating a transfer from the interactive communication session to a telephonic communication session\ See col. 7, lines 36-59.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-101 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 33-95 of copending Application No. 09/829515. Although the conflicting claims are not identical,

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they are not patentably distinct from each other because both contain similar subject matter within the claims such as: Facilitating a mediated communication session between first and second devices, the session including a request for implementing an interactive communication session.

Although the co-related application does not specifically state within the limitations, "implementing the interactive communication session between a first and third communication device", it would have been obvious to a person of ordinary skill in the art at the time of the present invention that the "selected follow through action", discussed in claims 73, 84, 92, and 94, provides a means for implementing the interactive communication session between a first and third communication device.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Stettner, U.S. Patent Publication 2002/0023130 is relevant to independent claims 1, 33, 47, 79, and 93, and discloses facilitating a mediated communication session between a first communication device and a second communication device.


Rouse et al., U.S. Patent Publication 2002/0103908 is relevant to claims 1-101, and discloses communication between mobile devices, and customizable responses.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hassan Phillips whose telephone number is (571) 272-3940. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (703) 308-6687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HP/
10/13/04


ZARNI MAUNG
PRIMARY EXAMINER